

Appl. No. : **10/814,966**
Filed : **March 30, 2004**

REMARKS

The specification has been amended as set forth above, and entry of that amendment is respectfully requested. No other amendments have been made.

Applicants gratefully acknowledge the rejoinder of all of the species in view of the lack of prior art found. The sole remaining issues are discussed below.

Amendments to the Specification

The Examiner noted that Application Serial No. 10/814,966 appears to claim subject matter disclosed in Application Serial No. 09/961,691. The Examiner noted that the instant '966 application did not include a reference to the '691 application in the first sentence of the specification, which is required if Applicants wish to rely on the filing date of the prior application under 35 U.S.C. § 199(e), 120, 121, or 365(c).

Applicants note that reference to the '691 application was previously submitted to the U.S. Patent and Trademark Office, but not in the first sentence of the specification or in an application data sheet. Applicants further note that the information concerning the benefit claim was recognized by the PTO as shown by its inclusion on the attached copy of the filing receipt. Thus, consistent with the direction provided in the Office Action, no petition or surcharge under 37 C.F.R. § 1.78(a) and § 1.17(t) are required. Finally, as required, the specification has been amended, as shown above, to include reference to the '691 application and to specify the relationship of the '966 application to the '691 application.

Double Patenting Rejection

The Examiner rejected Claims 71-122 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 6, 9 and 17 of U.S. Patent No. 6,753,161. The '161 patent is the parent of the instant '966 application. Attached herewith is a Terminal Disclaimer over the '161 patent. Applicants thus respectfully request that the Examiner's nonstatutory obviousness-type double patenting rejection of Claims 71-122 be withdrawn.

Appl. No. : **10/814,966**
Filed : **March 30, 2004**

CONCLUSION

Applicants have endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. Accordingly, amendments to the specification are presented above. In light of these amendments and remarks, allowance of the claims is respectfully requested. If the Examiner has any questions which may be answered by telephone, he is invited to call the undersigned directly. Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: February 22, 2007

By: M. T. Morley

Marc T. Morley
Registration No. 52,051
Attorney of Record
Customer No. 20,995
(619) 235-8550

3397855
020707



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPL NO. | FILING OR 371 (c) DATE | ART UNIT | FIL FEE REC'D | ATTY. DOCKET NO | DRAWINGS | TOT CLMS | IND CLMS |
|------------|---------------------------|----------|---------------|-----------------|----------|----------|----------|
| 10/814,966 | 03/30/2004 | 1636 | 1158 | 66666-029 | 10 | 70 | 4 |

CONFIRMATION NO. 8868

REPLACEMENT FILING RECEIPT



OC000000022339741

20995
KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

Date Mailed: 02/05/2007

Receipt is acknowledged of this regular Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please mail to the Commissioner for Patents P.O. Box 1450 Alexandria Va 22313-1450. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).

Applicant(s)

Manfred R. Koller, San Diego, CA;
Elie G. Hanania, San Diego, CA;
Timothy M. Eisfeld, San Diego, CA;
Bernhard O. Palsson, La Jolla, CA;

Assignment For Published Patent Application

Oncosis LLC

Power of Attorney:

Cathryn Campbell-31815

Domestic Priority data as claimed by applicant

This application is a CON of 09/961,691 09/21/2001 PAT 6,753,161
which is a CIP of 09/728,281 11/30/2000 PAT 6,514,722
which is a CIP of 09/451,659 11/30/1999 PAT 6,534,308
which is a CIP of 09/049,677 03/27/1998 PAT 6,143,535
which is a CIP of 08/824,968 03/27/1997 PAT 5,874,266

Foreign Applications

If Required, Foreign Filing License Granted: 06/08/2004

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US10/814,966**

Projected Publication Date: Not Applicable

Non-Publication Request: No

Early Publication Request: No

**** SMALL ENTITY ****

Title

Optoinjection methods

Preliminary Class

435

PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process simplifies the filing of patent applications on the same invention in member countries, but does not result in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at <http://www.uspto.gov/web/offices/pac/doc/general/index.html>.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, <http://www.stopfakes.gov>. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4158).

LICENSE FOR FOREIGN FILING UNDER Title 35, United States Code, Section 184 Title 37, Code of Federal Regulations, 5.11 & 5.15

GRANTED

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Bureau of Industry and Security, Department of Commerce (15 CFR parts 730-774); the Office of Foreign Assets Control, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

NOT GRANTED

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).